

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte FRANK E. JOUTRAS and RONALD J. HRUSKA JR.

---

Appeal No. 98-0985  
Application No. 08/271,022<sup>1</sup>

---

ON BRIEF

---

Before CALVERT, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 42-47, 49-52 and 72-74. Claim 48 has been allowed and claims 1-41, 53-71 and 75-82 have been canceled.

---

<sup>1</sup> Application for patent filed July 6, 1994. According to the appellants, the application is a continuation-in-part of Application No. 08/089,852, filed July 9, 1993.

Appeal No. 98-0985  
Application No. 08/271,022

We AFFIRM-IN-PART and enter a new rejection pursuant to  
37 CFR § 1.196(b).

BACKGROUND

The appellants' invention relates to a method of fitting an exercise device to a patient. An understanding of the invention can be derived from a reading of exemplary claim 42, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Whitelaw 1958	2,832,334	Apr. 29,
Makansi et al. 18, 1989 (Makansi)	4,822,037	Apr.
Dalebout 1989	4,850,585	July 25,
Airy et al. 1991 (Airy)	5,052,379	Oct. 1,
Hughes 1992	5,158,519	Oct. 27,

Claims 42-47, 49-52 and 72-74 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 42, 43, 49, 50, 52 and 72-74 stand rejected under 35 U.S.C. § 103 as being unpatentable over Airy in view of Dalebout.

Claims 44-47 stand rejected under 35 U.S.C. § 103 as being unpatentable over Airy in view of Dalebout, Whitelaw and Hughes.

Claim 51 stands rejected under 35 U.S.C. § 103 as being unpatentable over Airy in view of Dalebout and Makansi.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 17, mailed March 17, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 16, filed December 23, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

**The indefiniteness issue**

We will not sustain the examiner's rejection of claims 42-47, 49-52 and 72-74 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.

Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

With this as background, we find no basis for the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. In that regard, we agree with the appellants (brief, pp. 19-20) that a person of ordinary skill in the art would understand the scope (i.e., the metes and bounds) of the invention. In addition, with respect to the specific objection to claims 72 and 73, we note that parent claim 42 requires that the first and second sections of the jointed limb brace be on opposite sides of the joint of the limb.

**The obviousness issues**

*Claims 42, 43 and 72-74*

We sustain the examiner's rejection of claims 42, 43 and 72-74 under 35 U.S.C. § 103.

The teachings of Airy and Dalebout are generally set forth on pages 8-11 of the brief and pages 5-7 of the answer.

The examiner determined (answer, p. 6) that "Airy discloses the claimed device except for the resistance means being a friction means." With regard to this difference, the examiner then determined that

because these two resistance means [the frictional resistance means of Dalebout and the fluid resistance means of Airy] were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the frictional resistance means for the fluid resistance means of Airy.

Implicit in this rejection is the examiner's view that the above noted modification of Airy would result in a method which corresponds to the method recited in claims 42, 43 and 72-74 in all respects.



The appellants' argument (brief, pp. 21-25) with respect to claims 42, 43 and 72-74 is unpersuasive for the following reasons.

First, the appellants argue the deficiencies of each reference on an individual basis. However, nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

Lastly, the appellants argue that the claimed subject is not suggested by the applied prior art. We do not agree. When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be

fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In this case, it is our opinion that the teaching, suggestion or incentive supporting the combination comes from the applied prior art and not from impermissible hindsight.

In that regard, Airy teaches (column 11, lines 17-20) that various types of resistance units may be employed in conjunction with his invention to resist flexure or extension of the body joint or both flexure and extension as desired. Figures 6, 8, 9 and 11 of Airy set forth examples of suitable resistance units, including ones that utilize the shear resistance of a viscous fluid. Dalebout teaches a striding exerciser to which various resistance mechanisms may be adapted to offer resistance to the striding-type motion (abstract, lines 12-14, and column 8, lines 53-54). Specifically, Dalebout discloses both a resistance means (Figure 8) utilizing friction members 160, 162 and a resistance means (Figure 9) utilizing a hydraulic unit 190. Thus, Airy specifically suggests employing various types of resistance units as desired. Accordingly, we conclude that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Airy's resistance units to be frictional resistance units as suggested by Dalebout's Figure 8 especially in view of the prior art teachings that frictional resistance means and fluid resistance means are art-recognized alternatives.

For the reasons set forth above, the decision of the examiner to reject claims 42, 43 and 72-74 under 35 U.S.C. § 103 is affirmed.

*Claims 49-52*

We will not sustain the examiner's rejection of claims 49-52 under 35 U.S.C. § 103.

Claim 49 adds to parent claim 42 the addition limitation that "said resistance is controlled by a microprocessor program."

With regard to claim 49, the examiner states (answer, p. 6) that "Airy teaches the method of controlling the resistance means by a microprocessor program (column 15 lines 13-20)."

The appellants argue (brief, p. 23) that the subject matter of claim 49 is not taught by either Airy or Dalebout. The appellants point out that controlling resistance to movement with a microprocessor is not the same as taking data with a microprocessor.

We agree with the appellants that the subject matter of claim 49 is not suggested or taught by the applied prior art. Specifically, the microprocessor (referred to by the examiner in Airy at column 15, lines 13-20) does not control the resistance of the exercise apparatus. Accordingly, all the limitations of claim 49, and claims 50-52 dependent thereon, are not suggested by the applied prior art.<sup>2</sup> Thus, the decision of the examiner to reject claims 49-52 under 35 U.S.C. § 103 is reversed.

*Claims 44-47*

We sustain the examiner's rejection of claims 44-47 under 35 U.S.C. § 103.

The additional teachings of Whitelaw and Hughes are generally set forth on pages 11-12 of the brief and pages 7-9 of the answer.

---

<sup>2</sup> We have also reviewed the Makansi reference additionally applied in the rejection of claim 51 (dependent on claim 50) but find nothing therein which makes up for the deficiencies of Airy and Dalebout discussed above regarding claim 49.

The examiner determined (answer, pp. 7-8) that in addition to the difference noted above with respect to parent claim 42, Airy discloses the claimed device "except for a program means for varying the resistance of the first and second sections at different relative angles." With regard to this additional difference, the examiner then determined that

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to include the method of providing the resistance means of Airy in view of Dalebout with the adjustable resistance means of Whitelaw and Hughes, in order to provide the user different resistance relative to the positions of the first and second sections for a smooth resistance to the movement.

Once again, implicit in this rejection is the examiner's view that the above noted modifications of Airy would result in a method which corresponds to the method recited in claims 44-47 in all respects.

The appellants argue (brief, pp. 25-27) that there is no suggestion to combine the prior art to arrive at the claimed invention. We do not agree. Airy teaches (column 5, lines 1-5) that frame sections 18 and 20 are provided with a resistance unit to apply desired levels of resistance.

Dalebout teaches (column 7, lines 46-55) that the bolt member 156 and the nut member 166 together constitute an adjusting means for adjusting the frictional resistance to movement of the pedal means 34, 36 to the frame 16, 18. Whitelaw teaches (column 3, lines 25-45) that the resistive force of the friction member 56 may be varied by adjustment of the adjusting cap 49 to increase or decrease the force imposed on the friction member. Lastly, Hughes teaches (column 1, line 41, to column 2, line 51) a body exerciser having an adjustable calibration member that can increase or decrease the force imposed on the members (i.e., rotatable members 26 and stationary members 27 shown in Figure 3). It is our opinion that these teachings would have suggested to one of ordinary skill in the art at the time the invention was made to make the resistance means of Airy in view of Dalebout adjustable in order to provide a program for varying the resistance force over a portion of movement in accordance with the program at different angles between the first and second sections.

For the reasons set forth above, the decision of the examiner to reject claims 42, 43 and 72-74 under 35 U.S.C. § 103 is affirmed.

**New ground of rejection**

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 50-52 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention. Claim 50 recites that "said microprocessor program controls pressure between said first and second friction members." However, there is no proper antecedent basis for "said first and second friction members." The parent claims of claim 50 (i.e., claims 42 and 49) do not recite first and second friction members. It is our opinion that in view of the lack of antecedent basis for "said first and second friction members" a person of ordinary skill in the art would not be able to understand the scope (i.e., the metes and bounds) of the claimed invention.



CONCLUSION

To summarize, the decision of the examiner to reject claims 42-47, 49-52 and 72-74 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 42-47 and 72-74 under 35 U.S.C. § 103 is affirmed; the decision of the examiner to reject claims 49-52 under 35 U.S.C. § 103 is reversed; a new rejection of claims 50-52 under 35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by

final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

JVN/gjh

Appeal No. 98-0985  
Application No. 08/271,022

Page 21

VINCENT L. CARNEY  
P.O. BOX 80836  
LINCOLN, NE 68501-0836

APPEAL NO. 98-0985 - JUDGE NASE  
APPLICATION NO. 08/271,022

APJ NASE

APJ CALVERT

APJ CRAWFORD

DECISION: **AFFIRMED-IN-PART;**  
**37 CFR § 1.196(b)**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 30 Nov 98

**FINAL TYPED:**